Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM T. BALL

Appeal No. 2003-0223
Application No. 09/777,647

ON BRIEF

Before ABRAMS, FRANKFORT, and STAAB, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claim 5, which is the only claim pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a waste water strainer assembly.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Wentzel et al. (Wentzel)	1,661,983	Mar. 6, 1928
Steele	2,697,840	Dec. 28, 1954
Lantz et al. (Lantz)	3,169,254	Feb. 16, 1965
Mowery	5,363,518	Nov. 15, 1994

The admitted prior as set forth in on page 1 of the appellant's specification.

Claim 5 stands rejected under 35 U.S.C. § 103 as being unpatentable over the admitted prior art in view of Mowery, Lantz, Steele and Wentzel.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the Answer (Paper No. 11) and the final rejection (Paper No. 7) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 10) and Reply Brief (Paper No. 12) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

Claim 5 stands rejected as being unpatentable over applicant's admitted prior art, Mowery, Lantz, Steele and Wentzel (Paper No. 7, page 2). The examiner has described the admitted prior art in terms of portions of the appellant's invention as shown in Figures 1-4, and has concluded that it "teaches all claimed elements except for a circular horizontal flange (analogous to 28) of the drain assembly being threadingly attached via a bushing to an attachment bushing (analogous to 40)" (Paper No. 7, page 3). The examiner continues by pointing out features of the devices disclosed by Mowery, Lantz, Steele and Wentzel (Paper No. 7, pages 3 and 4). However, nowhere does the examiner explain how the device of the admitted prior is to be modified in

accordance with the teachings of each of the reference patents to meet the terms of claim 5, nor does he set forth the reasons why one of ordinary skill in the art would have been motivated to make such modifications. The examiner merely makes the unsubstantiated conclusionary statement that "the feature of threadingly attaching a circular horizontal flange to an attachment bushing, thereby creating a two-piece drain assembly, is well known in the art" (Paper No. 7, page 3). The examiner provides an indication of suggestion to combine references only with regard to Mowery, but in this regard he erroneously opines that Mowery provides a circular horizontal flange threaded into a drain assembly "to allow easy replacement of the flange in the event the flange becomes tarnished" (Paper No. 7, page 3) when, in fact, no such suggestion appears in Mowery, who teaches covering the flange with a replaceable decorative cap 52 to hide such tarnish (see column 1, line 67 et seq., column 4, lines 22-32, and column 5, lines 4-12). Thus, to the extent that Mowery suggests a solution to the tarnish problem, it is replacing the drain cap and not the circular flange.

The mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). The examiner has neither provided an explanation of how the device of the admitted prior art would be modified to meet the terms of claim 5 nor set forth the suggestion provided by the prior art for doing so, even though the appellant challenged him in this regard in the Brief

(pages 6 and 7) and the Reply Brief (pages 3-7). Therefore, the examiner clearly has not met the burden of establishing a prima facie case of obviousness with regard to the subject matter recited in claim 5. This being the case, the rejection is fatally defective, and we will not sustain it.

CONCLUSION

The rejection is not sustained.

The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS Administrative Patent Judge	)
CHARLES E. FRANKFORT Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
LAWRENCE J. STAAB Administrative Patent Judge	)

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